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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,153

11/13/2003

Dewayne M. Turner

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08/21/2006

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,153	Applicant(s) TURNER ET AL.	
	Examiner Jennifer H. Gay	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-34, 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 36-39 and 42-45 is/are rejected.
- 7) ☒ Claim(s) 32, 39, 46 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 36-38, and 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Bixenman et al. (US 6,575,246).

Regarding claims 36, 37: Bixenman et al. discloses an object holding service tool used to actuate a downhole valve that is not associated with the service tool (4:4-6). The tool includes a object holding service tool includes a sleeve **128** having a bore in which the object is slidably and sealingly engaged. The tool is adapted to slidably release the object with sufficient pressure applied to the object to cause a restraining device holding the object to release the object.

Regarding claim 38: Bixenman et al. further teaches an isolation string that includes an object activated valve **50** adapted to receive the object **103** from the tool and cause a flow path change in the valve. *It is noted that the valve 50 indirectly receives the object via the crossover mechanism 154.*

Regarding claims 42, 43, 45: Bixenman et al. discloses a valve system in a well that comprises an isolation string that includes the following features:

- An upper packer **7**.
- An isolation pipe **143** with a operable valve **56** and an object activated valve **50** (it is noted that column 4, lines 4-6 specifically indicates that the above valves can be located anywhere within the gravel packing tool **10** and are not limited to being within the service tool.

- An object holding service tool (5:45-6:2) coupled to the objected activated valve and adapted to release an object 103 to engage the object activated valve where the object activated valve receives the object from the service tool.

Regarding claims 44: The object activated valve includes a piston 148 adapted to at least partially assist in closing the valve.

Allowable Subject Matter

3. Claims 1-34, 40, and 41 are allowed.
4. Claims 32, 39, 46, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. In view of applicant's amendment, the objection to the specification has been withdrawn.
6. Applicant's arguments filed August 07th, 2006 have been fully considered but they are not persuasive.

Applicant has argued that Bixenman et al. does not teach that the bypass valve 50 can be activated by an object released by the service tool.

In response, the examiner notes that the valve 50 is indirectly activated by object 103 which will cause the increase in pressure in the tubing string 8 needed to start the activation of the valve. As noted in column 8, lines 6-11 and 60-67 and column 9, lines 1-3 and 22-25, the bypass valve is activated by a tubing string pressure that is greater than the tubing pressure used to set the packer. This indicates that the ball 103 sitting in the crossover mechanism is what causes the pressure to increase to the point necessary to activate the bypass valve as the tubing string pressure could not be increased without an obstruction of some sort.

Applicant has further argued that bypass valve is not part of the isolation string but rather is disclosed as being part of the service tool and that the claims require that the object activated valve not be part of the service tool. In response, the examiner notes that column 4, lines 4-6 specifically indicate that the bypass valve 50 can be a part of other portions of the apparatus other than the service tool.

Applicant has further argued that Bixenman et al. never teaches that the crossover mechanism 154 can be associated with the isolation string and the components of the crossover mechanism were relied upon by the examiner to teach the components of the object activated valve which is required to not be a portion of the service tool. While the examiner agrees with applicants argument with respect to claims 31 and 46, with respect to claim 36 the examiner notes that the service tool holds the ball which indirectly causes the activation of the bypass valve which is specifically recited as not needing to be part of the service tool.

With respect to claims 42-45, the examiner notes that the claims do not require that the object activated valve not be part of the service tool nor do the claims include the structure of the valve that would preclude the use of valve 50 to teach the claimed valve.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

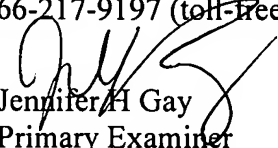
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

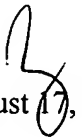
Art Unit: 3672

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H. Gay
Primary Examiner
Art Unit 3672

JHG 
August 17, 2006